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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,612	04/08/2004	Richard A. Sader	200312128-1	8658
22879 7590 03/06/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 03/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/820,612

Applicant(s)

SADER ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1,3-12,14,15,17-19 and 21-24.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

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Primary Examiner  
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**Attachment to Advisory Action**

1. Applicants' amendment filed 2/1/07 has been considered but the amendment has not been entered given that the amendment raises new issues that would require further consideration.

Specifically, previously claims 1, 15, and 19 each required "at least one cationic polymer" while now each claim requires "at least one cationic polymer wherein the at least one cationic polymer comprises at least one of a polyallylamine or a quaternized polyamine". Thus, whereas previously the claims encompassed any cationic polymer (such that the at least one phosphate ester surfactant did not precipitate with the cationic polymer), now the claims require at least one of a polyallylamine or a quaternized polyamine. Such narrowing of the scope of the claims would require further consideration. While it is noted that previously dependent claims 7 and 23 did require specific cationic polymer that included polyallylamine or a quaternized polyamine, these claims previously required cationic polymer "wherein the at least one cationic polymer comprises at least one of a polyethylene imine, polyamine, a quaternized polyamine, a polymer of hexamethylene guanide, a polymer of hexamethylene biguanide, or mixtures thereof". In the after-final amendment filed 2/1/07, claims 1, 15, and 19 are amended to recite "at least one cationic polymer wherein the at least one cationic polymer comprises at least one of a polyallylamine or a quaternized polyamine". Thus, while previously the scope of claims 7 and 23 included cationic polymer that is at least one of a polyethylene imine, polyamine, a quaternized polyamine, a polymer of hexamethylene guanide, a polymer of hexamethylene biguanide, or mixtures thereof, the after-final amendment limits the scope of all the present claims so that the cationic polymer is required to comprise at least one of a polyallylamine or a quaternized polyamine. Such narrowing of the scope of the claims would require further consideration.

Further, claims 7, 8, 23, and 24 would require additional consideration given that the after-final amendment limits the scope of these claims to now require mixture of cationic polymers, i.e. cationic polymer that comprises at least one of a polyallylamine or a quaternized polyamine and at least one of polyethylene imine, a polymer of hexamethylene guanide, a polymer of hexamethylene biguanide, or mixtures thereof (claims 7, 23) or at least one polyguanidine compound (claims 8, 24). Such mixture was previously not required and thus would require further consideration.

Additionally, claim 15 would require further consideration under 35 USC 112, second paragraph given that the scope of the claim is confusing given that some words appear to be missing at the end of the claim.

In light of the above, the after-final amendment filed 2/1/07 has not been entered.

It is noted that on pages 9-10 of the after-final amendment filed 2/1/07, applicants argue that the final rejection mailed 12/1/06 is improper given that the examiner has not met the initial burden of establishing a *prima facie* case of obviousness and request that the finality of the previous office action be withdrawn.

However, it is noted that the question of the prematureness of a final rejection is “purely a question of practice, wholly distinct from the tenability of the rejection”. See MPEP 706.07(c). It is further noted that that under present practice, “second or subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an

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information disclosure statement filed during the period set forth in 37 CFR 1.97(c)". See MPEP 706.07(a).

Thus, given that the new grounds of rejection set forth in the final office action mailed 12/1/06 were necessitated by applicants' amendment as discussed in paragraph 1 of the office action and given that the question of finality is distinct from the tenability of the rejection as set forth in MPEP 707.07(c), it is the examiner's position that the finality of the office action mailed 12/1/06 is proper.



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CS  
3/1/07